

REMARKS

Examiner Kendra D. Carter and Primary Examiner Sreeni Padamanabhan are warmly thanked for the courtesy shown at the interview of October 14, 2009 with Applicant's representative, Tanya Harkins, U.S. patent attorney, and Gérard Portal and Frédéric Portal, French and European Patent Attorneys.

In conformity with the Interview Summary, claims 1-84 are hereby cancelled and new claims 85 to 91 have been introduced in lieu thereof, without prejudice of disclaimer.

In view of the foregoing, the instant claims are believed to be in condition for allowance.

1. Allowable subject matter

At the outset of the Office Action, the Examiner states that "the Examiner attended several times to reach an agreement to amend the claims to the following allowable matter, but the Applicant's found the amendments unacceptable."

The proposed amendments, by the Examiner, have been duly noted.

Applicants were essentially accepting the proposed amendments except that Applicants did not wish to have forskolin limited to a plant source selected from an extract of *coleus forskolii* and *Plectranthus barbatus*.

Incidentally, Applicants observed that *Plectranthus barbatus* is another name for *coleus forskolii* (see application as filed, page 13, line 9).

Accordingly, Applicants have simplified the mention of a plant extract as an extract of *coleus forskolii* in the amended claims.

The Examiner's statements of reasons for allowance on pages 3 and 4 have been duly noted, i.e., the Examiner recognizes notably from Bombardelli, et al. (U.S. Patent No. 5,679,358) that "adenylate cyclase stimulators such as **forskolin** reduce the deposits of superfluous fat (Abstract) but Jackson et al. teach that phytosphyngosine increases the

level of the lipid materials in the stratum corneum in the skin (see column 1, lines 5-10 and column 3, lines 40-43). Nevertheless, the specific combination is not taught to provide a “slimming effect”.

In view of this, it appears that the Examiner recognizes that forskolin is known to reduce the deposit of superfluous fat and that forskolin is the active agent as an adenylate cyclase stimulator.

2. Claim rejections under 35 USC §112, first paragraph

Claims 31-35, 40-44 and 84 are rejected under 35 USC §112, first paragraph:

“because the specification, while being enabling for a composition comprising phytosphingosin and an extract of coleus forskolii both in a concentration of from 0.001% and 1%/weight to provide a slimming effect on the human body, does not reasonably provide enablement for phytosphingosine alone or in combination with any lipolytic agent to provide a slimming effect. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention commensurate in scope with these claims”

(Paragraph bridging pages 4 and 5 of the office action, emphasis added).

From page 5 to page 10, the Examiner discusses why the instant specification would not be enabled for **any** lipolytic agent.

It is respectfully submitted that it appears the Examiner recognizes explicitly that the instant specification is enabling for the combination of phytosphingosine with **forskolin**. This is supported by the Examiner’s statements themselves and notably from the passage discussing Bombardelli, et al. (U.S. Patent No. 5,179,358) on page 4 of the Office Action, where the Examiner recognizes that Bombardelli teaches “that adenylate cyclase stimulators such as forskolin reduce the deposit of superfluous fat...” As well as the statement that “the specific combination (namely explicitly of phytosphingosine and an adenylate cyclase stimulator such as forskolin) is not taught to provide a “slimming effect”. (Emphasis added)

The same is repeated on page 7, first full paragraph, of the Office Action wherein the Examiner recognizes “it would seem that the two claimed materials (namely phytosphingosine and forskolin) work opposite from each other.

For the Examiner, "particularly, forskolin reduce deposits of fat whereas phytosphingosine increases the level of fat". Thus, the combination of the two would not (be) expected to provide a slimming effect." (Emphasis added)

Accordingly, it is apparent that although it might be debatable whether phytosphingosine in combination with any lipolytic agent is enabled, it is apparent that the combination of phytosphingosine with forskolin is enabled by the instant specification.

This complies with the results shown in the as filed specification where the unexpected technical effect of the association of phytosphingosine with an extract of *coleus forskolii* (also named *Plectranthus barbatus*) which is rated at **80% of forskolin**, a molecule which is recognized for being an effector of adenylate cyclase (see page 13, lines 8-10 and page 15, lines 1-4 of the initial specification).

It is apparent for one skilled in the art that the active principle is forskolin which is rated at 80% in the extract of *Plectranthus barbatus* equivalent to *coleus forskolii*. In other words this extract is merely an impure form of forskolin.

As evidenced by the specification as filed, forskolin or a plant extract containing it as an adenylate cyclase enzyme activating agent, see specification on page 5, lines 11-14; page 6, lines 13-21 and also for the test on page 15, lines 1-3, (forskolin, a molecule which is recognized for being an effector of adenylate cyclase).

Accordingly, the specification is clearly enabling for the combination of phytosphingosine with forskolin and for effectiveness for slimming.

Thus, new claim 85 essentially follows the claim proposed by the Examiner wherein the cosmetically acceptable lipolytic agent forskolin or a plant extract containing forskolin is in a concentration of between 0.001% to 1% by weight of the total weight of the composition.

In view of this, new claim 85 is clearly corresponding to the patentable subject matter recognized by the Examiner.

Claim 86 is directed to the plant extract containing forskolin as an extract of *coleus forskolii*.

Claim 87 is directed to the plant extract containing forskolin is an extract of *coleus forskolii* containing 80% of forskolin, which is described in Example 2 and Table 3, page 16 of the as filed application.

Claims 88-90 are corresponding to claims which were indicated as allowable by the Examiner.

New claim 91 relates to specific proportions of phytosphingosine with forskolin as an extract of *coleus forskolii* of Example 5, namely 0.1% of extract of *coleus forskolii* associated with 0.05% of phytosphingosine.

In view of this, this application is now believed to be in condition for allowance and issuance of a notice of allowance is respectfully solicited.

CONCLUSION

In light of the foregoing, Applicants submit that the application is in condition for allowance. Applicants respectfully request that the Examiner contact the undersigned attorney if it is believed that such contact will expedite the prosecution of the application.


In the event this paper is not timely filed, Applicants petition for an appropriate extension of time. Please charge any fee deficiency or credit any overpayment to Deposit Account No. 14-0112.

Respectfully submitted,

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